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EXAMINER LE, KHANH H				
ART UNIT 3682		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/772,530

**Applicant(s)**

TIEN ET AL.

**Examiner**

KHANH LE

**Art Unit**

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is responsive to the correspondence filed 05/21/2010. Claims 1-22 were and remain pending. Claims 1 (method), 11 (system), 21 (computer readable medium) and 22 (system) are independent and amended.

#### *Specification*

2. The amendment to the specification is acceptable and has been entered.

#### *Claim Rejections - 35 USC § 112*

3a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**3b. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Representative claim 1 recites:

1. (Currently Amended) A method to ~~incentivize~~ of incentivizing a first party to refer a payment service to a second party, the method including: establishing an account for the second party, the account being associated with one of a plurality of bonus programs, the account being further associated with the first party; receiving a payment at a network-based payment machine and associating the payment to the account for the second party; and automatically awarding, using one or more processors, a payout to the first party based on the payment received by the account for the second party and on a plurality of payout conditions of the ~~one of the plurality of bonus program~~ programs that is associated with the account, the plurality of payout conditions including an initial hurdle and an initial payout, the plurality of payout conditions further including a condition that the received payment be made within a first marketplace of a plurality of marketplaces where the payment service may be used to receive

payments.

For “a condition that the received payment be made within a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments.”, Applicant cites for support Specification at [0041] :

*“The eligible volume 96 is utilized to identify payments that qualify for the bonus program. For example, a merchant may sell products or services in multiple electronic marketplaces; however, a referrer may only receive credit under a specific bonus program for payments made in markets that are identified by the eligible volume 96 field. For example, a referrer will receive credit for a payment made in Marketplace A provided that the eligible volume 96 field identifies Marketplace A. Other embodiments may capture payments made in more than one marketplace.”*

This is the only support found by the Examiner. This means that Applicant discloses, for a particular merchant, that a condition ( indicated in association with “eligible volume 96”) is Marketplace A (“*For example, a referrer will receive credit for a payment made in Marketplace A provided that the eligible volume 96 field identifies Marketplace A*”). Another condition may be Marketplaces A and B and C (“*Other embodiments may capture payments made in more than one marketplace.*”)

However, even though it is disclosed “a merchant may sell products or services in multiple electronic marketplaces”, the Applicant did not disclose that “eligible volume 96” indicates many marketplaces of the merchant “where the payment service may be used to receive payments.” and of that plurality, “a condition is that the received payment be made within a first marketplace” such as Market A.

Even though “a condition that the received payment be made within a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments” may be obvious from cited [0041], the standard is under 35 U.S.C. 112, first paragraph is not obviousness but inherency. See MPEP 2163.07(a).

**2163.07(a) Inherent Function, Theory, or Advantage**

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Correcting to “*a condition that the received payment be made at a first marketplace or a plurality of marketplaces at which the second party uses the payment service to receive payments*” would overcome the rejection.

Claims 11, 21, 22 have the same language and are rejected based on the same logic. All dependent claims of the above are rejected based on their dependency. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4a. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4b. **Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1: The claim scope is unclear since it is not clear what “a condition that the received payment be made within a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments.” means since as explained above, there is not clear support for the phrase.

Claims 11, 21, 22 have similar language and are rejected based on the same logic. All dependent claims of the above are rejected based on their dependency.  
Appropriate correction is required.

For prior art application the phrase is interpreted as “*a condition that the received payment be made at a first marketplace or a plurality of marketplaces at which the second party uses the payment service to receive payments*” . Amending as above would overcome this rejection.

***Claim Rejections - 35 USC § 103***

5a. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5b. **Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perri, US 2001/0020231 in view of Nosek US 7,191,151 (Nosek), Rowe US 2002/0151359 (Rowe), Warren US 2003/0101131 (Warren), and further in view of Official Notices (with e.g. Cohagan US 7856377 or Alspach-Goss et al. US 20060053056 as support).**

**Claims 1-3, 8, 11-13, 18, 21, 22:**

**Perri US 2001/0020231 discloses** computer assisted multi-level marketing compensation method wherein a message is sent from a first party to a second party, wherein the message includes a link to a processor (at which second party can sign up for a service) and the link has the first party identifier **so the first party can be automatically compensated** for specified activities of the 2<sup>nd</sup> party (see abstract, [0072], [0077]-[0079]). The referral message can be an email with links or a link on an ad banner posted on the website of a referring party (Figure 11, [0077]). Perri discloses the compensation of 1<sup>st</sup> party is for the 2<sup>nd</sup> party signing up to open an account (which can be an affiliate account, a shopping account or other service account, see [0079]).

**Perri discloses the compensation of 1<sup>st</sup> party is for the 2<sup>nd</sup> party signing up to open a account (which can be an affiliate account, a shopping account or other service account, see [0079]) but Perri does not specifically disclose** the compensation of 1<sup>st</sup> party is for the 2<sup>nd</sup> party signing up to open a payment account.

**Claim interpretation:**

It is interpreted a payment service is a service which enables buyers and sellers to make and receive payment for transacted merchandise. (Specification at [0002]), such as PayPal (Specification at [0023]).

As stated above commissions for referring a 2nd party to open an account is taught by Perri. The account could be a shopping account or **other service account**, see Perri, [0079]). Activities associated the account earns rewards for the referrer (Perri).

**Payment service systems are known before invention time, e.g. Nosek US 7191151 assigned to Paypal discloses such service** (see Nosek, abstract).

**As stated earlier, any business, payment service businesses need to attract clients, in this case merchants.** Thus it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to add the incentives given to referrers of any

service, as taught by Perri, to payment service systems such as Nosek, so to incent referrers to make referrals of merchants to sign up for the payment service.

Also, “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) at 417 (emphasis added).

The last sentence describes our case. There was, the Court continued, no need for the district court to “seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*”

**Here a method of compensation for referring clients to a service is taught by Perri. Market forces clearly show that on line payment services, as all businesses, need clients (merchants).** As reasoned in KSR, if a technique (here commissions for referrals) has been used to improve a device or process ( signing up for a service, as taught in Perri), and a person of ordinary skill in the art would recognize that it would improve similar devices or processes (here a payment service) in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” Here simple common sense dictates that the results would be predictable, i.e. that the referrers would be incented to refer the payment service to merchants.

(As stated earlier during prosecution, contrary to argument, the Examiner sees no conflict among the references. The Perri’s purchaser pays a merchant, thereby increasing the merchants revenues. The award to the referrer is based thereon. Similarly a payment service (e.g. Paypal disclosed by e.g. Nosek) makes money (transaction fees, usually paid customers-merchants (see Nosek , col. 2 lines 15-22). Thus payment services such as Paypal would want merchants to set up Paypal accounts, because every time their accounts are paid, Paypal makes money. Thus Paypal would award referrers of its service, just as done in Perri. Perri teaches automatically awarding the referrer for specified activities of the 2nd party (see abstract, [0072], [0077]-[0079]). Paypal is an automated transfer of funds between the parties, i.e. Paypal is paid automatically when merchants accounts are credited. There is no conflict combining Nosek (Paypal) to Perri: if the second parties in Nosek are the customers- merchants, when their accounts are paid into, Paypal is automatically paid, and there is no reason why in view of Perri, the referrers to Paypal cannot be paid automatically (upon payments into the merchants accounts since Paypal is also paid automatically)).

**Neither Perri nor Nosek teaches multi level rewards with initial hurdles and payouts, however Rowe, US 20020151359** in a casino player activity scheme, imposes requisites for qualifying for one or more awards. Players activities are tracked and player accounts reflect their activities (abstract). To be eligible for a particular prize a player has to have

a certain level of points "(and thus associated play) which may be necessary to qualify for that prize."

( See [0039]:

*"For example, in the event the casino employs a reward program where various prizes are awarded for levels of points (such as a first prize for a first minimum number of points, another prize for a higher minimum number of points, etc.), then information regarding the number of points necessary for particular plateaus or prizes may be detailed. In this manner, a player may determine their eligibility for a particular prize, or the level of additional points (and thus associated play) which may be necessary to qualify for that prize. "([0039]).*

Thus requiring a minimum amount or level of transactions (such as player plays or points in a casino context) ( i.e. an " initial hurdle") in order to give out a first prize (i.e. an " initial payout") corresponding to the minimum transaction level (" initial hurdle") is old and well-known, e.g. as taught by Rowe.

**Thus it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA")** to add to Perri the differential levels of awards based on levels of performance as taught by Rowe, to allow encouraging different levels of performance. In this case, it would also have been obvious to a PHOSITA to add to Perri, the first minimum awards ("initial payout") corresponding to first minimum level of performance (" initial hurdle") as taught by Rowe, to allow giving out the lowest level of reward upon achievement of a minimum performance. One reason for giving out such initial payouts is to set a threshold of performance and rewards, to show a link between performance and rewards, yet to encourage further performance with an initial reward.

As stated in KSR, applying the technique of Rowe in the a payment service referrals situation would have been obvious because a person of ordinary skill in the art would recognize that it would improve similar processes (here the payment service) in the same way. Here simple common sense dictates that the results would be predictable, i.e. that the referrers would be incented, just as the players in Rowe, to refer the payment service to merchants.

**Perri, in view of Nosek, and Rowe do not disclose a particular bonus program associated with the payment account among plural bonus programs.**

**However, Warren US 2003/0101131 discloses** a website for a potential reward recipients (e.g. account holder) to customize desired rewards features, such as criteria for earning rewards, methods of redeeming rewards, and types of compensation (abstract, [0004],[0047], [0065]). ( For example, rewards could be hotel, travel or shopping points, such as United Airlines miles or Marriott points, or cash, or merchandise. Payout conditions may be based on specific performance. Methods of redeeming awards may include automatic



redemption at a predetermined event, e.g., a number of points earned, or customer initiated redemption. See [0065]).

**Thus it would have been obvious to a PHOSITA to add Warren's teaching** of giving a choice of reward plans to the Perri, in view of Nosek, and Rowe system, and give such choice to the Perri's 1<sup>st</sup> party, to satisfy her.

It would further have been obvious in that case to associate the particular bonus program (for the benefit of the 1<sup>st</sup> party) with the account of the 2<sup>nd</sup> party so effect the rewards scheme, i.e. properly pay the 1<sup>st</sup> party according to her choice of rewards. It would also have been obvious to associate the 2<sup>nd</sup> party account identifier and the bonus program identifier to the 1st party identifier (which identifies to 1<sup>st</sup> party) so that the 1<sup>st</sup> party can be automatically paid upon the required performance of the 2nd party (as taught by Perri).

**Thus Perri, in view of Nosek, Rowe and Warren, as above discussed, disclose:**

A system, machine readable medium storing a set of instructions to execute a method to incentivize a first party to refer a payment service to a second party, the method including:

- establishing an account for the second party, wherein the account is associated with one of a **plurality of bonus programs** (interpreted as bonus programs that the 1st party can sign up for) and wherein the account is further associated with the first party;

- receiving a payment at a network-based payment machine and associating the payment to the account for the second party (Nosek: the second party being the merchant whose account is paid into and thereby earns Paypal fees, based on which the referrer earns his awards, see Response to arguments above)

- wherein the first party is eligible to participate in a plurality of bonus programs (further in view of Warren). (Note: this is also limitation of claims 8 and 18); and

- automatically awarding a payout to the first party based on the payment received by the account for the second party (Perri in view of Nosek) and on a plurality of payout conditions of the bonus program that is associated with the account, the plurality of payout conditions including an initial hurdle and an initial payout (further in view of Rowe and Warren);

- wherein the establishing of the account further includes associating a first identifier with the first party (per Perri) and a second identifier with the bonus program (per Warren) wherein the second identifier is utilized to identify the bonus program from the plurality of bonus programs (per Warren).

**The above references do not teach**

**the plurality of payout conditions further including a condition that the received payment be made within a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments.**

However, first, as stated above the additional condition is interpreted as “a condition that the received payment be made at a first marketplace or a plurality of marketplaces at which the second party uses the payment service to receive payments”.

Second it is clear that in a payment service context (such as Paypal taught by Ozer) the service gets paid a service fee only when the merchant is paid using its service. Thus it would have been common sense and thus obvious that a payment service such as Paypal would pay the referrer only if the payment is made via Paypal, i.e. at a marketplace at which the second party uses the payment service to receive payments.

Further Official Notice is taken that is are old and well-known, in incentive programs, to condition the rewards or incentives or the likes to specific transaction venues or locations depending on the business interests of the parties (e.g. merchants, third parties) involved. For example, see Cohagan US 7856377 which limits rewards to particular merchant locations (. “A loyalty system which is associated with pre-determined geographic locations and/or services and goods offered in a specific geographic area (. abstract)).

Cohagan teaches many possible variations on the rewards conditions based on the marketplace. (abstract: ” The system is configured with one product platform with a modularized approach to facilitate the development of market specific rewards and communication materials. In different embodiments, the loyalty points may be earned within a specific geographic location, then redeemed in one geographic location, a subset of locations or without restrictions. Similarly, the loyalty points may be earned in one geographic location, a subset of locations or without restrictions, then redeemed only in a specific geographic location. The geographic area information may be associated with the consumer, merchant, processing system and/or any other part of the overall system. The system may also facilitate the earning and redemption of points based upon product and/or service type. The system may also incorporate a conversion module which may convert the value of the loyalty points or value of the products/services based on the geographic area exchange rates.” )

As to a plurality of marketplaces for the same merchant, Official Notice is also taken that such is well-known. See e.g. Alspach-Goss et al. US 20060053056, which discloses **discounts on qualifying** purchases systems (abstract), with merchants with many stores, departments etc..

(i.e. “marketplaces”) and where the merchant “marketplaces” data is captured in many details in order to provide the discounts.

*[0130] FIG. 7 is flowchart illustrating an exemplary process for capturing and processing POS SKU data in accordance with the present invention. The association or matching of UPC and SKU data begins with POS data capture (step 702). When a consumer presents a consumer ID or supplementary member ID to a retailer 104 at the time of purchasing an item from the retailer 104, the consumer ID or supplementary member ID is processed by a rewards terminal 116 that recognizes the consumer ID or supplementary member ID and identifies the consumer as a participant in system 100. Purchase data is captured by the retailer POS terminal 112. Purchase data may include any of the data types noted above. For example, purchase data may include any of the following: a SKU number; a unit price; a total transaction price; the payment vehicle(s) used; a store ID which identifies the particular store location if a retailer operates more than one store; a department ID, if the store has multiple departments; the date of the transaction; the time of the transaction; the employee ID of the store clerk who facilitates the transaction; a POS terminal ID to identify the particular terminal conducting the transaction; any retailer-specific incentive program ID; and/or the like. The retailer POS terminal 112 creates a transaction file comprising the consumer data (including a consumer ID or supplementary member ID) and purchase data (including a SKU number associated with each item purchased), and the transaction file is then stored by the retailer processor 110 in database 111 (step 704).*

One would be motivated to follow the well-known methods of limiting incentives /rewards to specific merchants, locations, websites etc... or to specific marketplaces of a same merchant, as taught above by Cohagan or Alspach-Goss, as needed or desired, based on the particular reasons, e.g. business reasons, of the parties. For example, since the payment service would have to recoup its referral costs, it may charge a merchant different fees depending on its referral costs. Thus for example if a merchant is not doing well in a particular marketplace, it may ask for a discounted fee from the payment service for that market. In that case the payment service would want to lower or eliminate its referral bonuses for that market, in order to protect its revenues. As shown by all the references above, the level of skill in the prior art is very high so that any changes as to the rewards conditions can readily be implemented by a skilled artisan.

(Claims 11, 21 and 22 substantially parallel claim 1 in system and computer readable medium formats and are rejected on the same basis. Similarly for their dependents cited above which parallel the above cited method claims).

**Claims 4 and 14 (dependent on claims 1 and 11):**

Perri also discloses communicating the first identifier to the second party via the first party so the 1<sup>st</sup> party can be paid (i.e. reads on the first identifier is utilized by the second party to establish the account).

However Perri, in view of Nosek, Rowe and Warren do not specifically disclose communicating the second identifier (bonus program ID) to the second party via the first party, wherein the first identifier and the second identifier are utilized by the second party to establish the account.

However, as discussed above, Warren adds to Perri, in view of Nosek, and Rowe, satisfying the 1<sup>st</sup> party by giving her a choice of reward plans. In that case, it would have been obvious to a PHOSITA that the 2<sup>nd</sup> identifier for the bonus program also would have to be communicated to 2<sup>nd</sup> party by 1<sup>st</sup> party so the second party can submit both identifiers when opening his or her account, so 1<sup>st</sup> party could be appropriately rewarded under her chosen reward program.

**Claims 5-6 and 15-16 (dependent on claims 1 and 11):**

Warren further discloses configuring the plurality of bonus programs (programs), wherein each bonus program includes a plurality of payout conditions ([0065]) wherein the plurality of payout conditions is based on at least one of an eligible volume, a payout rate, a payout period (Warren at [0065] discloses automatic redemption at a predetermined event which reads on for example an end of month thus a monthly payout period), and a maximum payout.

As discussed above, Warren was added to provide satisfaction to Perri's affiliate with rewards choices. Further addition of this known redemption method, as taught by Warren, to Perri, would only yield the predictable result of allowing redemption periodically thus would have been obvious at invention time.

**Claims 7 and 17 (dependent on claims 1 and 11):**

The Perri combination as above discussed, further discloses wherein the payout includes at least one of an initial payout (when 2<sup>nd</sup> party opens an account, and the initial hurdle is met, the 1<sup>st</sup> party is paid the initial payout).

**Claims 9 and 19 (dependent on claims 6 and 16):**

Perri further discloses wherein the plurality of bonus programs include an at least one of an unrestricted bonus program (Perri does not put restriction on who can join the affiliate rewards program thus reads on an unrestricted bonus program) and a restricted bonus program.

**Claims 10 and 20 (dependent on claims 1 and 11):**

Warren further discloses wherein the payout is tendered in at least one of a plurality of national currencies (this is obvious for Warren's cash reward payments at [0065]). As discussed above, Warren was added to provide satisfaction to Perri's affiliate with rewards choices. Further addition of this known redemption method, as taught by Warren, to Perri, would only yield the predictable result of allowing redemption in cash in the designated currency thus would have been obvious at invention time.

***Response to Arguments***

6. Applicant's arguments filed 05/21/2010 have been fully considered but they are not persuasive.

Applicant argues "Perri assumes that each merchant has only one website, Perri, alone, does not teach or suggest that "a condition that the received payment be based on a payment made at a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments." However Ozer teaches the payment service and it is obvious a merchant using a payment service such as Paypal provides the functionalities on its website for a buyer to pay via Paypal. A marketplace is taken as a merchant website.

Applicant again argues that combining Perri to Rowe renders Rowe inoperable for its intended purpose because the rewards program of Perri is based on the activity of another person while the casino player activity scheme of Rowe is based on the activity of the same person. This is unpersuasive because the teaching is just the level of incentives scheme and nothing to do with the control of the persons involved. As stated earlier during prosecution, the Examiner sees no conflict in the combination of references. Applicant is referred to at least the last Office Action pages 3-5 for further discussion.

As to the new limitation, further references and motivation to combine are provided above.

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Monday-Wednesday 9:00-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boveja Namrata can be reached on 571-272-8105. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/

Primary Examiner, Art Unit 3682